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09/360,521

07/23/1999

SERGE RESTLE

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4299

22852

7590

07/30/2002

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/360,521

Examiner

Lauren Q Wells

Applicant(s)

RESTLE ET AL.

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

Claims 1-46 are pending. The Amendment filed 6/13/02, Paper No. 21, amended page 23 of the specification.

#### *Response to Applicant's Arguments/Amendment*

The Applicant's arguments filed 6/13/02 (Paper No. 21) to the rejection of claims 1-46 made by the Examiner under 35 USC 103, 112, and the judicially created doctrine of double patenting have been fully considered and deemed not persuasive.

The Applicant's arguments to the rejection of claims 1-32 and 34-46 made by the Examiner under 35 USC 102 have been fully considered and deemed persuasive. Therefore, the said rejections are hereby withdrawn.

#### *Double Patenting Rejection Maintained*

The rejection of claims 1-46 under the judicially created doctrine of double patenting over US Patent Nos. 6,028,041; 6,159,914; 6,162,424; and Application No. 09/759,165 is MAINTAINED for the reasons set forth in the Office Action mailed 3/13/02, Paper No. 20, and those found below.

Applicant argues, "the claims of the referenced patents and application do not teach or suggest an amphoteric/anionic surfactant ratio". This argument is not persuasive. While, the referenced patents and application do not teach the specific ratio, the claims of these patents and application encompass any and all ratios. Since, it is within the skill of one in the art to discover the optimum range, the instant claims are not distinguished from the claims of the referenced patents and application.

#### *112 Rejection Maintained*

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The rejection of claim 34 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 3/13/02, Paper No. 20, and those found below.

(i) The rejection of the term "quaternary derivatives of cellulose ether" is maintained, as it is vague and indefinite. While, the specification does provide one example, one example is not sufficient to define an undeterminable number of compounds. Regarding US Patent 4,240,450, the Examiner respectfully points out that Applicant can be her own lexicographer. Thus, it is not clear if the definition in 4,240,450, is that which is known in the art or is Applicant's own definition of a quaternary derivative of cellulose ether. This rejection can be overcome if Applicant clearly states on the record that the meaning of "quaternary derivatives of cellulose ether" is that defined by Col. 4, line 20-Col. 5, line 23 of US Patent No. 4,240,450.

### ***103 Rejection Maintained***

The rejection of claims 1-46 under 35 U.S.C. 103(a) as being unpatentable over Sebag et al. (WO 98/03155) in view of Hughes (5,567,428) in further view of Naito (5,476,649) is MAINTAINED for the reasons set forth in the Office Action mailed 3/13/02, Paper No. 20, and those found below.

Regarding Sebag, the Examiner respectfully points out that the WO number on the front page of 6,162,423 is incorrect. The correct WO number is 98/03155. Since Sebag, 6,162,423 was clearly identified, as the translated reference that was relied upon for the rejection, and since it was made of record, and made available to the Applicant, this rejection is maintained.

Applicant argues, "the art is unpredictable. . . Applicants submit that there is no basis of record to predict such results. Indeed, the unpredictability evidenced by these results shows that,

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but for hindsight based on the disclosure of the present application, there is no reasonable expectation of success for the Office's proposed substitutions and combinations". This argument is not persuasive. The Applicant has provided no data to establish the unpredictability of the art. The Examiner respectfully points out that showings of fact are much preferred to statements of opinion. In *re* Oelrich, 198 USPQ 210, 215 (CCPA 1978). Furthermore, in response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues, regarding unexpected results, "This is legally incorrect. To the contrary, 'the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness". This argument is not persuasive, as in the instant case, a prima facie case of obviousness has been established by the Examiner.

Applicant argues, "The Office does not cite Sebag for teaching an aminated silicone having an amine number of greater than or equal to 0.4meq/g". This argument is not persuasive, as the rejection was made over Sebag in view of Hughes and Naito and not over Sebag alone. The Examiner respectfully points out that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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1.4

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*Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues, “since Hughes teaches aminated silicones for a different purpose than Sebag uses silicones, there would have been no motivation to make the proposed substitution”, and “In order to established a prima facie case of obviousness, the Office would have to at least point to a motivation to make the proposed substitution of Hughes’ aminated silicones for Sebag’s silicones with respect to specific example compositions”. These arguments are not persuasive. The Examiner respectfully points out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In the instant case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the aminated silicones of Hughes for those of Sebag because a) Sebag and Hughes are both directed to cosmetic hair conditioning compositions comprising aminated silicones; b) Hughes teaches his aminated silicones as additionally providing an increased rate of drying; hence, substituting one for the other for hair conditioning purposes, would be within the skill of one in the art.

Applicant argues, “Sebag has not been cited for and does not provide any discussion related to an amphoteric/anionic surfactant ratio”. This argument is not persuasive. In the instant case, Sebag teaches that combinations of surfactants, preferably anionic and amphoteric surfactants, can comprise 5-50% of the composition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the amphoteric/anionic ratio of Sebag as greater than or equal to 0.2:1, since it has been held that where the general conditions

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of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Applicant argues, “the composition of Sebag Example 1 contains polydimethylsiloxanes, which is unsubstituted with amine groups. . .the Office has not shown a basis for substituting the alkylamino substituted silicones of Hughes for the non-aminated silicones of Sebag, such as the polydimethylsiloxane of Example 1”. This argument is not persuasive. Again, the Examiner respectfully points out that the references are not limited to their preferred embodiments, but are relied upon as a whole.

Applicant’s arguments regarding the amine number of the aminated silicones of Hughes are duly noted. However, the Examiner respectfully points out that an amine number is an inherent property of a chemical compound. Hence, if there is motivation to substitute one compound for another compound, wherein the one compound inherently possess an amine number, there is no need to separately address motivation for substituting amine numbers.

### ***103 Rejection Maintained***

The rejection of claims 1-46 under 35 U.S.C. 103(a) as being unpatentable over Decoster et al. (6,162,424) in view of Hughes in further view of Naito et al. is MAINTAINED for the reasons set forth in the Office Action mailed 3/13/02, Paper No. 20, and those found below.

Applicant argues, “First, according to the Office, Example 1 of Decoster ‘424 discloses. . .In contrast, as set forth more specifically in the claims, the presently claimed composition must have an amphoteric/anionic surfactant ratio of greater than or equal to 0.2:1”. This argument is not persuasive. It is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it

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fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). In the instant case, Decoster teaches that combinations of surfactants, preferably anionic and amphoteric surfactants, can comprise 0.1-60% of the composition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the amphoteric/anionic ratio of Decoster as greater than or equal to 0.2:1, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Applicant argues, “the Fluid DC 939 disclosed in Decoster ‘424 Example 1 does not have an amine number of greater than or equal to 0.4meq/g”. This argument is not persuasive, as it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In the instant case, Decoster teach amodimethicone and trimethylsilylamodimethicone, wherein the structures of these compounds fall within the formulas recited for aminated silicone polymers in claim 1 of the instant invention.

Applicant argues, “Decoster ‘424 teaches silicones to provide softness and other properties, which Hughes teaches alkylamino substituted silicones as drying agents. . . Given the different uses for the silicones of the two respective references, there would have been no motivation for the Office’s proposed substitution and, hence, no prima facie case of obviousness



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has been made". This argument is not persuasive, as the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In the instant case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the aminated silicones of Hughes for those of Decoster because a) Decoster and Hughes are both directed to cosmetic hair conditioning compositions comprising aminated silicones (see Example IX of Hughes); b) Hughes teaches his aminated silicones as additionally providing an increased rate of drying; hence, substituting one for the other for hair conditioning purposes, would be within the skill of one in the art.

### ***103 Rejection Maintained***

The rejection of claims 1 and 33 under 35 U.S.C. 103(a) as being unpatentable over Decoster (6,159,914) in view of Naito et al. is MAINTAINED for the reasons set forth in the Office Action mailed 3/13/02, Paper No. 20, and those found below.

Applicant argues, "Decoster '914 does not teach an aminated silicone having an amine number greater than or equal to 0.4 meq/g". This argument is not persuasive, as it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In the instant case, Decoster teaches aminosilicones of formula (IV) of the instant invention.

### ***Unexpected Results***

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It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

Again, the data on pages 22-23 have been considered. However, the data is not convincing. The showings of the aminated silicone are not commensurate in scope with independent claim 1.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
July 24, 2002

RUSSELL TRAYERS  
PRIMARY EXAMINER  
GROUP 1200